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Docket: 0357-0018

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TLR
9/10/97
Response

In re PATENT application of)
Joseph B. SAINTON)
Serial No. 08/709,112) Art Unit: 2611
Filed: September 6, 1996) Examiner: E. Urban
For: APPARATUS AND METHODS FOR)
NETWORKING OMNI-MODAL RADIO)
DEVICES)

9-11-97
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CERTIFICATE OF MAILING

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RESPONSE

Honorable Commissioner of Patents and Trademarks

Washington, D.C. 20231

Sir:

The Examiner's Official Action dated February 12, 1997 has been received and its contents carefully noted. Filed concurrently herewith is a *Request for a Three Month Extension of Time* which extends the shortened statutory period for response to August 12, 1997. Accordingly, applicant respectfully submits that this response is being timely filed.

Paragraph 2 of the Official Action rejects claims 1-2, 4, 9-14, 16 and 21-22 as obvious based on the combination of U.S. Patent 5,261,117 to Olson and U.S. Patent 4,144,496 to Cunningham et al. The Official Action asserts that Olson discloses every

limitation recited in claim 1 except that Olson fails to disclose the claimed capacity detection means for generating a frequency request to temporarily reassign radio spectrum, which the Official Action asserts is taught by Cunningham et al. Finally, the Official Action asserts that it would have been obvious to have combined the teachings of Olson and Cunningham "for the simple purpose of acquiring a more efficient system." With respect to the further imitations directed to the use of a digital interface and a modem for interconnecting the transceiver with external devices, the Official Action asserts that such features would have been obvious "in order to provide the user with increased versatility."

It is noted that the burden of establishing a *prima facie* case of obviousness lies with the Patent Office and to establish such *prima facie* case of obviousness, (1) there must be some suggestion or motivation (either in the references themselves or in the knowledge generally available to one of ordinary skill in the art) to combine the reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art references when combined must teach or suggest all the claim limitations. See *MPEP* § 2142-43. *MPEP* § 2143 makes clear that in order for a *prima facie* case of obviousness to be established, the combination of references must "teach or suggest all of the claim limitations." "The references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious." *Ex parte Clapp*, 227 USPQ 972,973 (Bd. Pat. App. & Inter. 1985). When the motivation to combine the teachings of the prior art references is not immediately apparent, the examiner has the duty of explaining why the combination of the references is proper. *MPEP* § 2142.

In the present application, however, it is respectfully submitted that the first prong above has not been met in that there has been an insufficient showing that one of skill in the art would have been motivated to combine the references to Olson and Cunningham

as done in the Official Action. In this regard, it is noted that it is not sufficient that the references could be combined, but rather the prior art, when taken as a whole, must suggest that they should be combined. The Official Action asserts as motivation the "simple purpose of acquiring a more efficient system" and providing "the user with increased versatility." It is respectfully submitted, however, that such general allegations are insufficient to rise to the level of motivation required under the law to establish a *prima facie* case of obviousness. Of course, every person of skill in the art wishes to enhance system efficiency and provide greater versatility to a user of the system, but absent some clear suggestion in the prior art that such imprecise goals can be achieved by combining the references to achieve the present invention, a *prima facie* case of obviousness cannot be maintained.

Furthermore, the law is clear that the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious. In the present application, no such express or implied motivation is believed to be present and the examiner has not provided any convincing line of reasoning as to why it would be obvious to combine the teachings of the prior art to achieve the present invention.

Also, even should it ultimately be determined that one of skill in the art would be motivated to combine the teachings of Olson and Cunningham, it is submitted that the third prong above -- that the prior art references when combined must teach or suggest all the claim limitations -- has not been met in this case. As noted in the previous response filed in the parent of this application, Applicant respectfully asserts that neither Olson nor Cunningham disclose or suggest reallocation of radio spectrum comprising radio frequency reallocating means to reassign temporarily radio spectrum from a wireless communication network. That is, Olson provides for a radio transceiver to use either a trunked radio communication network or a conventional mobile relay communication network, depending on availability, but does not reassign radio spectrum allocated to one

of these networks to the other. Furthermore, other distinguishing features discussed in that earlier response are also believed to be patentably distinguish the present invention from the prior art of record.

Paragraph 3 of the Official Action rejects claims 3, 5-8, 15 and 17-20 as obvious based on the combination of Olson, Cunningham and U.S. Patent 5,134,709 to Bi et al. It is respectfully submitted that Bi et al. does nothing to overcome the deficiencies noted above with respect to Olson and Cunningham and reconsideration of this rejection is also requested for the reasons discussed above.

For all of the above reasons, it is submitted that claims 1-24 are now in proper condition for allowance. If the Examiner feels that any further discussions would be beneficial in this matter, it is requested that the undersigned be contacted.

Respectfully submitted,



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